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REMARKS

Claims 1-50 are all the claims presently pending in the application. Claims 40-42, 44, 46-50 have been amended to make minor edits to the claims.

It is noted that the claim amendments are made only to assure grammatical and idiomatic English and improved form under United States practice, and are not made to distinguish the invention over the prior art or narrow the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, 4-7, 9-17, 20-37 and 40-49 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yamauchi et al. (U.S. Patent No. 6,020,982). Claims 3, 8, 18, 19, 38, 39 and 50 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamauchi in view of Litwin (U.S. Patent No. 6,374,228).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as recited, for example, in claim 1) is directed to an image data output apparatus for outputting to a second medium, which is a different type of medium than a first medium, image data recorded in the first medium received from a customer. The apparatus includes a reader for reading out the image data recorded in the first medium, an output unit for outputting the image data to the second medium, a digital contents storage unit for storing digital contents to be stored in the first medium, a selector for selecting from a plurality of the digital contents stored in the digital contents storage unit the digital contents to be provided to the customer based on a predetermined selection condition, and a recorder for recording the selected digital contents in the first medium (Application at page 14, lines 11-13).

Conventionally, when a customer of a photoshop has data on a first medium (e.g., memory card) recorded on a second medium (e.g., paper or CD-R), the first medium is returned

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to the customer in the same condition as when the customer arrived at the photoshop (Application at page 1, line 32-page 2, line 5). The customer may then be handed a publicity handout (e.g., a paper including advertising or sales information) by the clerk working at the photoshop.

The claimed invention, on the other hand, includes a recorder for recording the selected digital contents in the first medium (Application at page 14, lines 11-13). Thus, for example, after the data on a memory card is recorded on paper, the memory card may be returned to the customer with selected digital contents (e.g., advertising and/or sales information) recorded thereon, which may eliminate the need for the clerk to hand such information (e.g., paper advertisement or sales information) to the customer.

II. THE ALLEGED PRIOR ART REFERENCES

A. Yamauchi

The Examiner alleges that the invention of claims 1, 2, 4-7, 9-17, 20-37 and 40-49 are anticipated by Yamauchi. However, Applicant respectfully submits that Yamauchi does not teach or suggest each and every element of the claimed invention.

Yamauchi discloses an electronic still camera which may record an image onto a memory card (Yamauchi at Abstract).

However, Yamauchi does not teach or suggest *"a recorder for recording said selected digital contents in the first medium."*, as recited in claim 1 and similarly recited in claims 21, 23 and 40.

As noted above, in an exemplary aspect of the claimed invention, after the data on a memory card is recorded on paper, the memory card may be returned to the customer with selected digital contents (e.g., advertising and/or sales information) recorded thereon, which may eliminate the need for the clerk to hand such information (e.g., paper advertisement or sales information) to the customer.

Clearly, these features are not taught or suggested by Yamauchi.

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Indeed, Applicant would point out that a purpose of the claimed invention is to record image data of a first medium (e.g., memory card, etc.) onto a second medium (e.g., paper, CD-R, etc.) and record digital content (e.g., sales information, advertising information, etc.) onto the first medium (e.g., an extra space of the first medium). Yamauchi, on the other hand merely relates to an electronic still camera for converting a captured optical image and recording the image data and header information on a recording medium.

Thus, Yamauchi is clearly different from the claimed invention. For example, the claimed invention may record digital contents (e.g., sales and/or advertising information) on a first medium (e.g., memory card). Moreover, the digital contents are not necessarily image data.

In Yamauchi, on the other hand, the disc recorder 802 and tape recorder 803 record image data and header information from a memory card 400 (e.g., a first medium) onto a disk, tape, etc. (e.g., a second medium). Clearly, the disc recorder 802 and tape recorder 803 are unrelated to the claimed invention which records image data of a first medium (e.g., memory card, etc.) onto a second medium (e.g., paper, CD-R, etc.) and records digital content (e.g., sales information, advertising information, etc.) onto the first medium (e.g., an extra space of the first medium).

Indeed, the Examiner attempts to rely on Figure 1 to support his allegations. Specifically, the Examiner attempts to equate the disc and tape recorders 802, 803 with the recorder of the claimed invention. Clearly, this is incorrect.

In fact, Yamauchi merely teaches that the camera 11 records digital image data in the memory card 400, and the digital image data may be delivered from the memory card 400 to the disc and tape recorders 802, 803 via the editing machine 600 (Yamauchi at col. 9, lines 1-22). Thus, nowhere does Yamauchi teach or suggest that the disc and tape recorders 802, 803 record selected digital contents **in a first medium**.

Indeed, Applicant would out that the Examiner attempts to equate the memory card 400 in Yamauchi with a "first medium". However, **nowhere does Yamauchi teach or suggest that the disc and tape recorders 802, 803 record anything onto the memory card 400.** Therefore, the Examiner's allegations are clearly unreasonable.

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In short, Yamauchi does not teach or suggest an apparatus in which image data is read out of a first medium and output to a second medium, and selected digital contents are stored and recorded in the first medium.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by Yamauchi. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. Litwin

The Examiner alleges that Yamauchi would have been combined with Litwin to form the invention of claims 3, 8, 18, 19, 38, 39 and 50. However, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Litwin discloses a rebate advertising system in which an individual who affixes advertisements such as bumperstickers to his car can be provided a rebate (Litwin at Abstract).

Applicant respectfully submits that these references would not have been combined as alleged by the Examiner. Indeed, these references are completely clearly unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, contrary to the Examiner's allegations, neither of these references teaches or suggests their combination.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Yamauchi, nor Litwin, nor any combination thereof teaches or suggests *"a recorder for recording said selected digital contents in the first medium."*, as recited in claim 1 and similarly recited in claims 21, 23 and 40.

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As noted above, in an exemplary aspect of the claimed invention, after the data on a memory card is recorded on paper, the memory card may be returned to the customer with selected digital contents (e.g., advertising and/or sales information) recorded thereon, which may eliminate the need for the clerk to hand such information (e.g., paper advertisement or sales information) to the customer.

Clearly, these features are not taught or suggested by Litwin. Indeed, Applicant would point out that the Examiner is merely relying on Litwin as allegedly disclosing some other feature of the claimed invention.

In fact, as noted above, Litwin deals only with a rebate advertising system in which an individual who affixes advertisements such as bumperstickers to his car can be provided a rebate (Litwin at Abstract). Nowhere does Litwin even teach or suggest an image data output apparatus for outputting image data (e.g., recorded in first medium received from a customer) to a second medium. Certainly, Litwin does not teach or suggest a recorder for recording selected digital contents in the first medium. Therefore, Litwin clearly does not make up for the deficiencies of Yamauchi.

Therefore, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-50, all the claims presently pending in the application, are patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

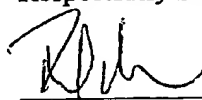
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below to discuss any other changes deemed necessary for allowance in a telephonic or personal interview.

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The Commissioner is authorized to charge any deficiency in fees, including extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 9/30/05



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing was filed by facsimile with the United States Patent and Trademark Office, Examiner Jamie Vent, Group Art Unit # 2616 at fax number (571) 273-8300 this 30th day of September, 2005.



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